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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,651	12/07/2000	Jerry Walter Malcolm	AUS9-2000-0655-US1	9971
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IBM CORPORATION (RUS) C/O SIEGESMUND & ASSOCIATES 4627 NORTH CENTRAL EXPRESSWAY, SUITE 2000 DALLAS, TX 75206			EXAMINER STORK, KYLE R	
			ART UNIT 2178	PAPER NUMBER

DATE MAILED: 11/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/731,651

Applicant(s)

MALCOLM ET AL.

Examiner

Kyle R. Stork

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-13, 15, 16, 18-20, 22-24 and 26-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-13, 15, 16, 18-20, 22-24 and 26-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This final office action is in response to the amendment filed 6 September 2005.
2. Claims 1-9, 11-13, 15-16, 18-20, 22-24, 26-30 are pending. Claims 1, 12, and 22 are independent claims. The rejection of claims 1-9, 11-13, 15-16, 18-20, 22-24, 26-30 under 35 U.S.C. 102 and 103 are withdrawn as necessitated by the amendment.

Claim Objections

3. Claims 1, 12, and 22 objected to because of the following informalities: The claim recites that "at least one compliant database field may have a plurality of field values (claim 1, line 4, emphasis added)" and "fields that may be used (claim 1, line 11, emphasis added). These limitations do not require that the limitations occur, simply that they "may" occur. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-9, 11-13, 15-16, 18-24, 26-27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maxwell et al. (US 6589290, filed 29 October 1999, hereafter Maxwell) and further in view of Pennell et al. (US 6910179, filed 9 November 1999, hereafter Pennell).

As per independent claim 1, Maxwell discloses a method for inserting data into an electronic form having at least one field that is compliant with a standard, the method comprising:

- Providing a data storage location having at least one field that is compliant with the standard, wherein at least one compliant field may have a plurality of field values (column 9, line 36- column 10, line 8)
- Providing a set of rules that select one field value from each compliant database field having a plurality of field values (column 12, lines 51-63)
- Applying the set of rules to select one field value from each complaint data storage location having a plurality of field values (column 13, line 29- column 14, line 18)
- Matching each compliant data storage location field with the corresponding compliant form field (column 14, line 19-28)
- Inserting each selected field value into the corresponding compliant form field (column 14, lines 29-41)
- Wherein the standard is a protocol extension that specifies the fields that may be used in the electronic form and in the database (column 14, line 62- column 15, line 32)
- Whereby a completed form is created (column 8, lines 40-55)

Maxwell fails to specifically disclose storing data within a database. However, Pennell discloses storing form filling data in a database (column 2, line 61- column 3, line 6). It would have been obvious to one of ordinary skill in the art at the time of the applicant's

invention to have combined Maxwell's method with Pennell's method, since it would have allowed a user an organized method for storing user data.

As per dependent claim 2, Maxwell and Pennell disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Maxwell further discloses the method further comprising responsive to application of a rule from the set of rules and selection of a field value, changing values in other related fields (column 14, lines 29-41; column 10, lines 9-29: Here, based upon the rules applied, related fields are similarly filled).

As per dependent claim 3, Maxwell and Pennell disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Maxwell further discloses the method further comprising receiving the electronic form from a requester (column 18, lines 35-49: Here, when a user purchases an item, the presentation of a form requiring user information is a request for information from a requester).

As per dependent claim 4, Maxwell and Pennell disclose the limitations similar to those in claim 3, and the same rejection is incorporated herein. Maxwell further discloses the method further comprising providing a network as a conduit for receiving the electronic form from the requester (column 12, lines 19-50).

As per dependent claim 5, Maxwell and Pennell disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Maxwell further discloses the method further comprising transmitting the completed form across a network (column 20, lines 3-24).

As per dependent claim 6, Maxwell and Pennell disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Maxwell further discloses the method further comprising:

- Displaying the plurality of field values in at least one complaint field having a plurality of field values (column 10, lines 9-29)
- Selecting one of the field values so that the selected field value is inserted into the corresponding compliant form field (column 10, lines 9-39)

As per dependent claim 7, Maxwell and Pennell disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Maxwell further discloses providing at least one flag in the electronic form so that the flag determines which field value the rules select from each compliant database field having a plurality of field values (column 12, line 64- column 13, line 14: Here, the control type description specifies what form of data to use in filling the form).

As per dependent claim 8, Maxwell and Pennell disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Maxwell further discloses the method wherein the set of rules further resolve conflicts that may arise among fields (column 12, line 51- column 13, line 28: Here, the data type required to fill a field resolves conflicts between data fields).

As per dependent claim 9, Maxwell and Pennell disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Maxwell further discloses the method further comprising transmitting the electronic form to a requestor (column 18, lines 35-49).

As per dependent claim 11, Maxwell and Pennell disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Maxwell further discloses the method further comprising determining whether each selected field value inserted into the completed form is acceptable (column 13, lines 29-58: Here, the information entered may be verified to ensure that it complies with the rules of the form).

As per independent claim 12, the applicant discloses the limitations similar to those in claim 1. Claim 12 is similarly rejected.

As per dependent claim 13, the applicant discloses the limitations similar to those in claim 2. Claim 13 is similarly rejected.

As per dependent claim 15, Maxwell and Pennell disclose the limitations similar to those in claim 12, and the same rejection is incorporated herein. Maxwell further discloses wherein the electronic form further comprises at least one flag assigning at least one complaint form field to a first category (column 12, line 64- column 13, line 14), and the computer program further comprises:

- Means for assigning a second category to at least one field value in each complaint data storage location filed having a plurality of field values (column 9, line 50- column 10, line 35: Here, the data is categorically sorted)
- Means for comparing the first category with the second category (column 12, line 51- column 13, line 28: Here, the categories of data relates to the type of information that may be filled with the data)
- If the first category is equivalent to the second category, means for inserting each field value assigned to the second category into each compliant form field

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assigned to the first category (column 12, line 51- column 13, line 28: Here depending upon the type of data required by the control type description, the forms are filled)

As per dependent claim 16, the applicant discloses the limitations similar to those in claim 8. Claim 16 is similarly rejected.

As per dependent claim 18, the applicant discloses the limitations similar to those in claim 9. Claim 18 is similarly rejected.

As per dependent claim 19, Maxwell and Pennell disclose the limitations similar to those in claim 12, and the same rejection is incorporated herein. Maxwell further discloses the method further comprising:

- Means for displaying the plurality of field values in at least one compliant data storage location field having a plurality of field values (column 13, lines 29-39)
- Means for inserting the selected field value into the corresponding compliant form filed (column 13, lines 29-39; column 14, lines 29-41)
- Means for changing at least one other field value associated with a field of the electronic form (column 13, lines 29-39: Here, a user can override the form-filling algorithm by dragging and dropping information into the form fields)

As per dependent claim 20, the applicant discloses the limitations similar to those in claim 11. Claim 20 is similarly rejected.

As per independent claim 22, the applicant discloses the limitations similar to those in claim 1. Maxwell further discloses wherein the first computer is a client

computer and the second computer is a remote computer containing forms (column 9, lines 37-61; column 11, line 57- column 12, line 50).

As per dependent claim 23, Maxwell and Pennell disclose the limitations similar to those in claim 22, and the same rejection is incorporated herein. Maxwell further discloses a display device coupled to the controller, wherein the controller is further operable to display the electronic form and at least one field value from each compliant data storage location field having a plurality of field values (column 19, line 9- column 20, line 24; column 10, lines 9-29).

As per dependent claim 24, the applicant discloses the limitations similar to those in claim 6. Claim 24 is similarly rejected.

As per dependent claim 26, Maxwell and Pennell disclose the limitations similar to those in claim 24, and the same rejection is incorporated herein. Maxwell further discloses the method wherein the controller is further operable to change at least one field value in a second data storage location field in response to the selection of a field value from the first compliant data storage location field (column 13, lines 29-39).

As per dependent claim 27, Maxwell and Pennell disclose the limitations similar to those in claim 26, and the same rejection is incorporated herein. Maxwell further discloses the controller operable to transfer the completed form from the first storage device to the second storage device through the communications medium (column 20, lines 3-17).

As per dependent claim 29, Maxwell and Pennell disclose the limitations similar to those in claim 12, and the same rejection is incorporated herein. Maxwell further

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discloses wherein the electronic form further comprises at least one flag assigning at least one complaint form field to a first category (column 12, line 64- column 13, line 14), and the computer program further comprises:

- Means for displaying the plurality of field values in at least one compliant data storage location field having a plurality of field values (column 13, lines 29-39)
- Means for a user to select a field value from the first compliant data storage location field having a plurality of field values (column 13, lines 29-39)
- Means for changing a field value in a second compliant data storage location field in response to the user selecting a field value in the first compliant data storage location field (column 13, lines 29-58: Here, the completed forms that a user fills in, are tracked and changes to field values are stored)
- Means for assigning a second category to at least one field value in each complaint data storage location field having a plurality of field values (column 9, line 50- column 10, line 35: Here, the data is categorically sorted)
- Means for comparing the first category with the second category (column 12, line 51- column 13, line 28: Here, the categories of data relates to the type of information that may be filled with the data)
- If the first category is equivalent to the second category, means for inserting each field value assigned to the second category into each compliant form field assigned to the first category (column 12, line 51- column 13, line 28: Here depending upon the type of data required by the control type description, the forms are filled)

- Means for transmitting the completed electronic form to a requester (column 18, lines 35-49)

6. Claims 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maxwell and Pennell and further in view of Higley (US 6065048, filed 29 October 1997).

As per dependent claim 28, Maxwell and Pennell disclose the limitations similar to those in claim 12, and the same rejection is incorporated herein. Maxwell fails to specifically disclose use of a MIME protocol. However, Higley discloses use of a MIME protocol (column 6, lines 49-67).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Maxwell and Pennell's program product with Higley's program product, since it would have allowed a user to incorporate a standard protocol into data transfer.

As per dependent claim 30, the applicant discloses the limitations similar to those in claim 28. Claim 30 is similarly rejected.

Response to Arguments

7. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

The applicant's amendment have changed the scope of the claims and distinguished the claims over the prior art of record. However, the examiner has applied

the Maxwell and Pennell, and the combination of the two in conjunction with the Higley reference in order to address the amended claim limitations.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R. Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kyle Stork
Patent Examiner
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PRIMARY EXAMINER